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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,649

09/07/2006

Serge Kurowski

Q95985

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23373 7590 06/01/2010
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

GIONTA, ALLISON

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

06/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Office Action Summary	Application No. 10/598,649	Applicant(s) KUROWSKI, SERGE	
	Examiner ALLISON GIONTA	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/7/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-5, drawn to a rotating-frame rail.

Group 2, claim(s) 6-10, drawn to a method of manufacturing a rotating-frame rail.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature is identified to be a first flange and a second flange connected by a at least two structural elements forming a web wherein one of the flanges also has attached a wear plate. However, Stock teaches a circular car from element (Fig. 3, 20 or 22) comprising an inner beam (Fig. 3, 21 or 23) connecting two flanges (Fig. 3, top and bottom of 20 or 22) and a wear plate positioned below it (Fig. 3, 25 or 27). While there are not at least two beams connected the top and bottom flanges, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate an additional beam, extending from the top flange to the bottom flange, for the benefit of providing increased support and stability to the structure. Therefore, the current invention does not make a greater contribution over the prior art. Thus, groups I and II lack unity of invention.

3. During a telephone conversation with John Mion on 5/20/2010 a provisional election was made without traverse to prosecute the invention of group I, claims 1-5.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 6-10 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

4. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, applicant attempts to claim a "rotating-frame rail", however, from the claims it is unclear what applicant is actually claiming. First, from the preamble of the claim, it is inferred that the "rotating-frame rail" rotates, however, it is unclear from the claims what claimed feature enables the device's rotation. Further, applicant claims that the "transverse section is roughly in an H shape". However, from the drawings, it appears that the transverse section is more similar to that of the Roman numeral "II". Lastly, it is generally unclear from the claim in light of the specification what the device is. The device is described in way that does not clearly convey the true structure of the device. For example, the claim claims that the flanges are circular or polygonal, but when the drawings are referenced for further clarification, the drawings appear to show the structure as having rectangular flanges. Further, in claim 3 applicant claims the web to be "formed by a tube having a rectangular cross section". It is unclear what this "tube" structure is as there is no further description or depiction in the drawings. There is no further description or depiction of this apparatus. The claims should be amended for clarify the structure of the device being claimed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

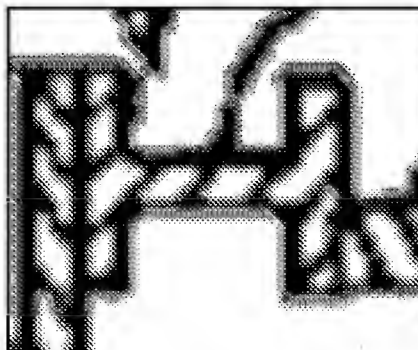
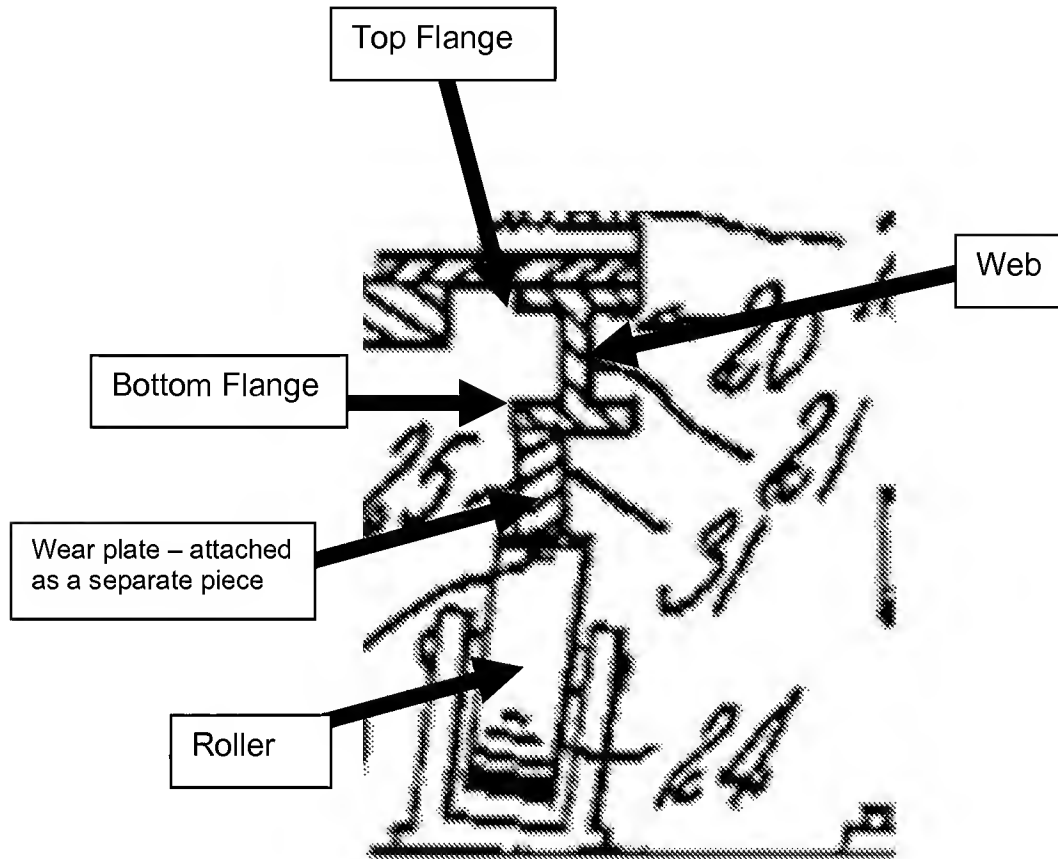
9. **Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Stock (3139404, made of reference on applicant's IDS).

Regarding claims 1, 3, 4 and 5, Stock teaches a rotating-frame rail comprising a first circular flange (Fig. 3, top of 20 or 22; col. 2, lines 66-67) with an external surface (Fig. 3, top of flanges) that are intended to cooperate with at least one filtration cell (col. 2, lines 66-71) and an internal surface (Fig. 3, bottom of top flange of 20 or 22), a second circular flange (Fig. 3, bottom flange part of 20 or 22; col. 2, lines 66-67) having an external (Fig. 3, bottom of bottom flange part 20 or 22) and an internal surface (Fig. 3, top of bottom flange part of 20 or 22) a web (Fig. 3, 23) between the upper and lower flanges wherein the transverse section is roughly an H shape (see image reproduced below). A wear plate (fig. 3, 25 or 31) is below the second flange (fig. 3, bottom flange of 20 or 22) in order to form a contact surface for support rollers (Fig. 3, 24 or 26). Stock teaches several rails (Fig. 3, 20 and 22) with filtration cells (fig. 1, 38) disposed on top in

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a circular manner (Fig. 1, filtration cells (38) are arranged around the center in a circular way).



Transverse 'H' cross-section

Stock does not teach wherein the steel web comprises at least two steel cross-ties curved or bent in a parallel fashion or wherein the web is formed by a tube having a rectangular cross section and long sides forming the parallel cross ties.

However, applicant's recited structure merely describes an I-beam (pictured above and taught by Stock) with an additional, identical and separate inner support. Applicant merely duplicates the inner support. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a second support, identical to and separate from the first for the benefit of increasing the strength and stability of the frame-rail. It is well-known that the addition of an extra support helps distribute the weight and provide a more stable, sturdy structure. The mere duplication of parts, without any new or unexpected results, is within the ambit of one of ordinary skill in the art. See *In re Harza*, 124 USPQ 378 (CCPA 1960) (see MPEP § 2144.04).

Further, regarding the specific description of the design of the cross-ties, the courts have held that the change in form or shape, without any new or unexpected results, is an obvious engineering design. See *In re Dailey*, 149 USPQ 47 (CCPA 1976) (see MPEP § 2144.04). It would have been obvious to one of ordinary skill in the art at the time of the invention to manipulate the design of the structure for aesthetic or structural purposes.

Stock teaches that the wear plate is a separate piece (see the figure reproduced above, the different coloring of the wear plate and the flange indicate the separation). Stock is silent to the way in which the wear plate is connected to the flange. However, it is notoriously well-known in the art that nuts and bolts are commonly used to detachably

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connect two objects for the benefit of easy removal, or interchangeability. One of ordinary skill in the art at the time of the invention would have been motivated to incorporate a well-known attachment means, such as bolts, into Stock's invention for the benefit of detachably connecting the wear plate to the flange for the benefit of easy removal and replacement after the wear plate breaks down from the rollers.

Claim 2 is considered product-by-process claim. The cited prior art teaches all of the positively recited structure of the claimed apparatus or product. The determination of patentability is based upon the apparatus structure itself. The patentability of a product or apparatus does not depend on its method of production or formation. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP § 2113).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Johnson (5644888) shows that structural supports can have many different designs including that of an I-beam shape with a hollow center support beam (Fig. 3).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALLISON GIONTA whose telephone number is (571)270-1767. The examiner can normally be reached on M-F: 9am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571)272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/
Primary Examiner, Art Unit 1797

/AMG/